

REMARKS

I. Introduction

With the addition of new claims 22 and 23, claims 10 to 23 are pending in the present application. In view of the foregoing amendments and following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

II. Rejection of Claims 10 to 21 Under 35 U.S.C. § 102(e)

Claims 10 to 21 were rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 5,877,957 ("Bennett"). It is respectfully submitted that Bennett does not anticipate the present claims for the following reasons.

Claim 10 relates to a programmable controller including a processing unit, a display screen including a menu-assisted user interface, an operator unit including a button, the button capable of being switched to an active mode using a programmable function, and a housing. Claim 10 has been amended herein without prejudice to recite that the programmable controller includes at least one signal input terminal, at least one signal output terminal. Support for the foregoing amendments may be found, for example, on page 3, lines 20 to 22 of the Specification. Claim 10 further recites that the processing unit, the display screen, the operator unit, the at least one signal input terminal and the at least one signal output terminal are disposed in the housing. Claim 10 further recites that a switching function of the controller is programmable in a programmed sequence according to predetermined functions using the menu-assisted user interface. Claim 10 further recites that an operation of the button is capable of affecting a switching sequence of the switching function when the button is in the active mode.

Claim 20 relates to a programmable controller including a processing unit, a display screen, an operator unit including a button switchable to an active button in accordance with a programmable function, and a common housing. Claim 20 has been amended herein without prejudice to recite that the programmable controller includes at least one signal input terminal, at least one signal output terminal. Support for the foregoing amendments may be found, for example, on page 3, lines 20 to 22 of the Specification. Claim 20 further recites that the processing unit, the display screen, the operator unit, the at least one signal input terminal and the at least one signal output terminal are accommodated in the common housing. Claim 20 further recites an arrangement configured to program

switching functions on the basis of a predetermined function in accordance with a menu-assisted user interface on the display screen. Claim 20 further recites a sequence of a switching function dependent on operation of the button.

Claim 21 relates to a programmable controller including a processing means, a display means, operating means including a button switchable to an active button in accordance with a programmable function, and a common housing. Claim 21 has been amended herein without prejudice to recite that the programmable controller includes at least one signal input terminal, at least one signal output terminal. Support for the foregoing amendments may be found, for example, on page 3, lines 20 to 22 of the Specification. Claim 21 further recites that the processing means, the display means, the operating means, the at least one signal input terminal and the at least one signal output terminal are accommodated in the common housing. Claim 21 further recites means for programming switching functions on the basis of a predetermined function in accordance with a menu-assisted user interface on the display means. Claim 21 further recites a sequence of a switching function dependent on operation of the button.

Bennett purportedly relates to an automation system for programming appliances having programmable controllers, programmable devices and trigger devices that are stated to communicate over a communication link 16. Abstract. A trigger event is stated to be any signal broadcast over communication link 16 to the programmable controller 12. See col. 5, lines 57 to 58. Bennett states that communication link 16 may include home power lines, RF transmissions, messages over dedicated wiring, messages sent as data over phone lines and optical signals. See col. 6, lines 22 to 27. Nowhere does Bennett disclose, or even suggest, at least one signal input terminal and at least one signal output terminal as recited in amended claims 10, 20 and 21. As indicated above, Bennett states that the programmable and trigger devices communicate over a single communication link 16. Abstract. Therefore, Bennett does not disclose input and output terminals, as recited in amended claims 10, 20 and 21.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d

831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Bennett does not disclose, or even suggest, at least one signal input terminal and at least one signal output terminal, as recited in claims 10, 20 and 21. Therefore, it is respectfully submitted that Bennett does not anticipate claims 10, 20 and 21.

As for claims 11 to 19, which ultimately depend from claim 10 and therefore include all of the limitations of claim 10, Applicant respectfully submits that these claims are patentable for at least the same reasons provided above in support of the patentability of claim 10. Therefore, withdrawal of the 35 U.S.C. § 102(e) rejection and allowance of claims 11 to 19 is respectfully requested.

Applicant submits the following additional reasons in support of patentability of claims 11 to 19. With respect to claim 11, Applicant submits that Bennett does not disclose, or even suggest, that an operation of the button can simulate at least one signal input when the button is in the active mode, as recited in claim 11. With respect to claim 12, Applicant submits that Bennett does not disclose, or even suggest, that the programmed sequence of the switching function is interrupted when the button is operated in the active mode, as recited in claim 12. With respect to claim 13, Applicant submits that Bennett does not disclose, or even suggest, that the switching function can be interrupted by operation of the button in the active mode, as recited in claim 13. With respect to claim 14, Applicant submits that Bennett does not disclose, or even suggest, that the operation of the button is performable at any point of the programmable switching function, as recited in claim 14. With respect to claim 15, Applicant submits that Bennett does not disclose, or even suggest, a second button capable of affecting the switching function, as recited in claim 15. With respect to claim 16, Applicant submits that Bennett does not disclose, or even suggest, a second button and wherein the second button is capable of being switched to an active mode, as recited in claim 16. With respect to claim 17, Applicant submits that Bennett does not disclose, or even suggest, that the display screen is capable of displaying an instruction to operate the active button, as recited in claim 17. With respect to claim 18, Applicant submits that Bennett does not disclose, or even suggest, a display screen capable of displaying an instruction to operate the active button and wherein the instruction to operate the active button is accompanied by an acoustic signal, as recited in claim 18. With respect to claim 19, Applicant submits that Bennett does not disclose, or even suggest, a switching function of the controller arranged to switch between input voltages applied to the at least one signal input terminal and the at least one signal output terminal, as recited in claim 19.

In summary, Applicant respectfully submits that Bennett does not anticipate claims 10 to 21. Therefore, withdrawal of the 35 U.S.C. § 102 (e) rejection and allowance of claims 10 to 21 is respectfully requested.

III. Rejection of Claim 18 Under 35 U.S.C. § 103 (a)

Claim 18 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Bennett and U.S. Patent No. 5,997,167 (“Crater et al.”). Applicant respectfully submits that claim 18 is patentable over the combination of Bennett and Crater et al. for the following reasons.

Claim 18 depends from claim 10. As indicated above, Bennett fails to disclose, or even suggest, at least one signal input terminal and at least one signal output terminal, as recited in claim 10. Nor does Crater et al. remedy the deficiencies of Bennett. Therefore, the combination of Bennett and Crater et al. does not disclose all of the limitations of claim 18.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As stated above, the combination of Bennett and Crater et al. fails to disclose, or even suggest, at least one signal input terminal and at least one signal output terminal, as recited in claim 10, from which claim 18 depends.

The Office Action alleges that it “would have been obvious to one of ordinary skill in the art to use the speaker of Bennett to play an acoustic signal that accompanies the display of an instruction to operate the active button in order to capture the operator’s attention as supported in Carter.” Office Action at p. 4. It is respectfully submitted that the cases of *In re Fine*, *supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Office Action’s generalized assertions that it would have been obvious to modify or

combine the reference do not properly support a § 103 rejection.' It is respectfully submitted that those cases make plain that the Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the reference relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 21 U.S.P.Q.2d at 1943, 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

More recently, the Federal Circuit in the case of *In re Kotzab* has made plain that even if a claim concerns a "technologically simple concept" -- which is not the case

here -- there still must be some finding as to the “specific understanding or principle within the knowledge of a skilled artisan” that would motivate a person having no knowledge of the claimed subject matter to “make the combination in the manner claimed,” stating that:

In this case, the Examiner and the Board fell into the hindsight trap. The idea of a single sensor controlling multiple valves, as opposed to multiple sensors controlling multiple valves, is a technologically simple concept. With this simple concept in mind, the Patent and Trademark Office found prior art statements that in the abstract appeared to suggest the claimed limitation. But, there was no finding as to the specific understanding or principle within the knowledge of a skilled artisan that would have motivated one with no knowledge of Kotzab’s invention to make the combination in the manner claimed. In light of our holding of the absence of a motivation to combine the teachings in Evans, we conclude that the Board did not make out a proper prima facie case of obviousness in rejecting [the] claims . . . under 35 U.S.C. Section 103(a) over Evans.

In re Kotzab, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000) (emphasis added). Again, it is believed that there have been no such findings.

Accordingly, there is no evidence that the references relied upon, whether taken alone, combined or modified, would provide the features and benefits of claim 18 herein. It is therefore respectfully submitted that claim 18 is allowable for these reasons. Therefore, withdrawal of the 35 U.S.C. § 103(a) rejection and allowance of claim 18 is respectfully requested.

IV. New Claims 22 and 23

New claims 22 and 23 have been added herein. It is respectfully submitted that new claims 22 and 23 do not add any new matter and are fully supported by the present application, including the Specification. See the Specification, for example, at p. 3, lines 5 to 6 and 22 to 24. Because claims 22 and 23 contain features analogous to claims 10 to 21 it is respectfully submitted that claims 22 and 23 are allowable over Bennett and over the combination of Bennett and Crater et al. for at least the same reasons submitted above in support of the patentability of claims 10 to 21.

V. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

KENYON & KENYON

Dated: 2 October 22, 2003 By:

R. L. Mayer
Richard L. Mayer
Reg. No. 22,490
R. L. Mayer
42,191

One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO. 26646